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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/572,847

03/21/2006

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PHILIPS INTELLECTUAL PROPERTY & STANDARDS

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BRIARCLIFF MANOR, NY 10510

EXAMINER

CHEVALIER, ROBERT

ART UNIT

PAPER NUMBER

2621

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/572,847	<b>Applicant(s)</b> FONTIJN ET AL.	
	<b>Examiner</b> ROBERT CHEVALIER	<b>Art Unit</b> 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-17 and 20-24 is/are rejected.
- 7) ☒ Claim(s) 7, 18 and 19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-2, 5-6, 8-9, 17, and 21-24, are rejected under 35 U.S.C. 102(b) as being anticipated by Tzelnic et al (P.N. 6,366,987).

Tzelnic et al discloses a data storage apparatus that shows all the limitations recited in claims 1, 21, including the feature of storing a plurality of content items of a storage means (See Tzelnic et al's Figure 1, component 21), and the feature of storing reduced reference information to a backup memory separate from the storage means as specified in the present claims 1, 21. (See the capability of compacting the storage unit for storage in the secondary storage as shown in Tzelnic et al's Figure 1, component 22, Figure 7, component 125, claim 6, and column 27, lines 32-35).

With regard to claims 5-6, the feature of the first and the second recording means recited thereof is present in Tzelnic et al. (See Tzelnic et al's Figures 12-13).

With regard to claim 8, the feature of the reduced reference information comprising catalogue information as specified thereof is present in Tzelnic et al. (See Tzelnic et al's Figure 8, component 134).

With regard to claim 9, the feature of the removable medium being a DVD as specified thereof is present in Tzelnic et al. (See Tzelnic et al's Figure 12).

With regard to claims 17, and 22-24, the feature of the means for restoring and retrieving content items in response to the reduced reference information as specified thereof is present in Tzelnic et al. (See Tzelnic et al's claim 1).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 2-4, are rejected under 35 U.S.C. 103(a) as being unpatentable over Tzelnic et al (P.N. 6,366,987) in view of Official Notice.

Tzelnic et al disclose a storage apparatus that shows substantially the same limitations recited in claims 2-4, including the feature of reducing reference information associated with the plurality of content of items as specified in the present claims 2-4. (See the capability of compacting the storage unit for storage in the secondary storage

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as shown in Tzelnic et al's Figure 1, component 22, Figure 7, component 125, claim 6, and column 27, lines 32-35).

Tzelnic et al fail to disclose the feature of the reference information associated with the content items would include information of the user profile as specified in the present claims 2-4.

Examiner takes Official Notice in that it is notoriously well known in the video recording/reproducing art to have reference information associated with recorded content items, wherein the reference information would include information of the user profile as specified in the present claims 2-4.

It would have been obvious to one skilled in the art to modify the Tzelnic et al's apparatus wherein the reference information associated with the content items provided thereof would incorporate information of the user profile in the same conventional manner as is well known in the video recording/reproducing art. Examiner has taken Official Notice. The motivation is to better identify the recorded content items at reproduction as suggested in the prior art.

6. Claims 10-16, and 20, are rejected under 35 U.S.C. 103(a) as being unpatentable over Tzelnic et al (P.N. 6,366,987) and Official Notice as applied to claims 2-4, 10-11 above, and further in view of Mankovitz (P.N. 5,541,738).

The proposed combination of Tzelnic et al and Official Notice indicated above disclose a data storage apparatus that shows substantially the same limitations recited in claims 10-16, 20, including the feature of the reduced information related to the content items as specified in the present claims 10-16, 20. (See the capability of

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compacting the storage unit for storage in the secondary storage as shown in Tzelnic et al's Figure 1, component 22, Figure 7, component 125, claim 6, and column 27, lines 32-35).

The proposed combination fails to specifically disclose the feature of the reference information comprising identity information relating to title of the content item, broadcast time, broadcast channel, of a broadcast programme as specified in the present claims 10-16, 20.

Mankovitz discloses a video recording/reproducing apparatus which includes the capability of recording video program and identity information relating to title of the content item, broadcast time, broadcast channel, of a broadcast programme as specified in the present claims 10-16, 20. (See Mankovitz's Figure 1, and the corresponding disclosure).

It would have been obvious to one skilled in the art to modify the proposed combination indicated above wherein the recording means provided thereof would incorporate the capability of video program and identity information relating to title of the content item, broadcast time, broadcast channel, of a broadcast programme, in the same conventional manner as is shown by Mankovitz. The motivation is to better identify the recorded content items as suggested by Mankovitz.

***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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8. Claims 23-24 are rejected under 35 U.S.C. 101 because the claim is directed to a program having nonfunctional descriptive material.

Programs not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are neither physical “things” nor statutory processes. See, e.g. Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory) and merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make it statutory. See MPEP 2106.IV.B.1.

9. Claims 7, and 18-19, are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT CHEVALIER whose telephone number is (571)272-7374. The examiner can normally be reached on MM-F (9:00-6:30), second Monday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ROBERT CHEVALIER/  
Primary Examiner, Art Unit 2621  
May 6, 2009.